

**REMARKS**

Claims 1-40 are pending in this application. No amendments have been made by this response. Once again, in reviewing the outstanding Office Action, the undersigned notes that the Information Disclosure Statement filed on March 29, 2002 has not been acknowledged by the Examiner. The Examiner is respectfully requested to return the initialed PTO-1449 Form that accompanied this Information Disclosure Statement, indicating consideration of the PCT document cited therein.

The undersigned would like to thank the Examiner and his Supervisory Primary Examiner, Matthew Bella for the courtesies extended Applicant's representative in the interview dated January 6, 2004. During this interview, the references were discussed. Applicants reiterated the position set forth in Applicants first Office Action in the present application, to the effect that there was not motivation to modify the More, et al. reference to include structure described in Sekendur and that this lack of motivation rendered the rejection insufficient, although the Examiner wanted Applicants to resubmit arguments in distinction over the references.

**The Art Rejections**

The Examiner has rejected claims 1-3, 5-10, 15, 18, 21-24 and 26-34 under 35 U.S.C. § 103, alleging that these claims are unpatentable over the More patent in view of the patent to Sekendur. This rejection is respectfully traversed for the following reasons.

The present application is generally directed to a system and method for digitizing a free hand graphic produced by tracing a pattern with an optical sensor across a surface

having a position coding data pattern positioned thereon. According to the teachings of the present application, a second area of a surface containing a position coding pattern identifies a property for the free hand graphics such as the color, line thickness, or type of line of the free hand graphic<sup>1</sup>. Note that each of the claims of the present application requires a surface or base to include a position coding pattern. As used in the specification of the present application, the term "position coding pattern" refers to a pattern provided on a surface which pattern may be read to detect position. The present application is generally directed to the use of a second area of the surface of a base to define a property of a free hand graphic recorded by reading position codes on a first area of the surface. For reasons set forth hereinbelow, the Examiner rejection combination does not set for a *prima facie* case of obviousness and the Examiner's rejection is therefore clearly deficient in teaching the concepts of the present application.

U.S. Patent 5,194,852 to More, et al. discloses an electro-optical tablet for input and output of hand-written information. The system includes a flat display, such as a liquid crystal display and a sensor for sensing the position of a stylus or pen on the display. Sensing is performed through the use of a grid of horizontal and vertical electrodes used to both control the display elements and to electro statically sense the position of the pen on the display surface.

The Examiner's attention is directed to column 6, lines 49-65 and Figure 3a of More. The operation of Figure 3a is discussed beginning on column 14, line 43 and extending through the paragraph onto column 15. Note that beginning column 15, line 6, it is clear that the pen sense control means 2 uses the X-Y grid of conductors to perform stylus

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<sup>1</sup> These are intended to be non-limiting examples of a property for the free hand graphic.

detection and position encoding. Thus, the stylus does not determine position from a position code provided on a surface. Instead, the surface in the More reference determines the location of the stylus by detecting its presence at a sensed location. It is clear that when considering the operation of the More reference, the More reference cannot be said to disclose a position coding pattern as mistakenly contended by the Examiner. The More reference simply fails to disclose any pattern which indicates position provided on a surface, instead using a sensor beneath the surface to sense pen location. This may not be fairly characterized as a position coding pattern. Thus, for this reason, the More reference is even more deficient than recognized by the Examiner.

The Examiner applies the secondary reference to Sekendur to supplement the teachings of the More reference. Although Sekendur is directed to a vastly different position coding technique, a position code is used in the Sekendur process to indicate position to a wand or pen. Thus, Sekendur is at least directed to the class of products to which the present claims are directed.

The Sekendur reference discloses a system where a pen device digitizes its movement by detecting and decoding a position coding pattern. The positions coded on a substrate or base in the Sekendur product are not assigned any functions or processing rules and thus are not divided into visually distinct position coding areas having differing functions.

The Examiner contends that while the More reference does not disclose a drawing device having an optical sensor function to detect a position from a position coding pattern, this is disclosed by the Sekendur reference. **However, the Examiner has not pointed to**

any motivation to make this combination or any reason why one of ordinary skill in the art would be motivated to make such a combination. Indeed, the Examiner's proposed combination would replace the structure of the More reference described in detail in this reference with diverse structure from the Sekendur reference without any motivation to make the substitution. Indeed, it is unclear why the Examiner believes that one of ordinary skill in the art would be motivated to modify a device which detects the position of the pen from a sensor arrangement under a display surface to modify this arrangement to read position codes imprinted on the surface. There is simply no motivation to make such a change as asserted by the Examiner.

The Examiner implies at page 4, lines 10-12 of the Office Action, that the combination of references might be motivated by the desire to provide an apparatus and interface that is easy and simple to use. However, the Examiner bases this decision on the hindsight interpretation from Applicants own specification and his combination would likely increase the complexity of the More device.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references must teach or suggest all of the claim limitations. The teaching or suggestion to make the claim combination in the reasonable expectation of success must be found in the prior art, and not based on Applicants disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ 2d 1438 (Fed.Cir. 1991).

As mentioned above, there are at least two flaws with the Examiner's position. Firstly, contrary to the assertion of the Examiner, the More reference does not disclose a position-coding pattern as recited in the claims. More, et al. is directed to a different class of technology, the touch panel technology which employs a sensor in the display for sensing stylus or pen position.

The Examiner's rejection further fails to provide motivation for the Examiner's alleged combination. In order for a *prima facie* case to exist, the prior art must suggest the desirability of the claimed invention, providing motivation to make the combination proposed by the Examiner. *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ 2d 1453, 1457-58 (Fed.Cir. 1998). The level of skill in the art cannot be relied upon to provide this suggestion to combine the references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ 2d 1161 (Fed.Cir. 1999). In the instant rejection, the Examiner lacks any motivation to combine the teachings of the Sekendur reference with those of More. In making such a combination, a substantial modification in the functionality of the More reference necessarily needs to be made. One of ordinary skill in the art would not be suggested how to make this modification. Indeed, the modification proposed by the Examiner creates numerous technical difficulties which would not be readily resolved. Consequently, no *prima facie* case is made and the combination cannot fairly be made.

Note that the mere fact that the references can be modified, does not render the results in combination obvious unless the prior art suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ 2d 1430 (Fed. Cir. 1990). Certainly

nothing within the references suggests or motivates the modification proposed by the Examiner.

In view of the failure of the Examiner to establish a *prima facie* case of obviousness with respect to the pending claims, it is respectfully submitted that all claims patentably distinguish over the combination of references applied by the Examiner. The Examiner is accordingly respectfully requested to reconsider and withdraw the outstanding rejection and pass the claims of the present application to Issue.

The Examiner adds the Allard reference to the above-mentioned rejection combination to reject dependent claim 4, uses the Weinmann publication to support his rejection of claims 11-14 and 25, and uses the Kiraly reference to reject claims 16, 17, 19, and 20. The citation of these references effectively supports Applicants' position as expressed above with regard to the Examiner's failure to make a *prima facie* case. The Allard, Weinmann, and Kiraly references are all directed to devices that use screen borne buttons with mouse or touch-pad activation systems. None of these references relate to the sensing of a position coding pattern and thus are non-analogous references. Since the secondary references cited by the Examiner are also non-analogous in their failure to relate to devices sensing position via a position coding pattern, they cannot correct the deficiencies present in the Examiner's basic rejection combination and accordingly, reconsideration and withdrawal of the secondary rejections are believe appropriate.

#### **Response to Examiner's Response to Arguments**

The examiner appears to fail to appreciate applicant's position as expressed above. More does not disclose a position coding pattern nor any reason or motivation to modify

More based on the teachings of Sekendur. The examiner's combination is motivated merely by hindsight knowledge based on applicant's specification. Consequently, no *prima facie* case has been established by the examiner.

**CONCLUSION**

For all of the above-stated reasons, reconsideration and withdrawal of all outstanding rejections and allowance of all claims are believed appropriate.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

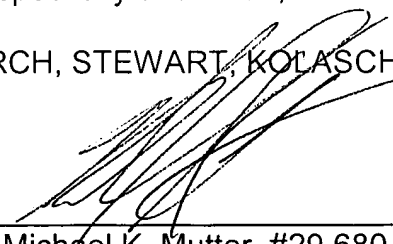
Pursuant to 37 C.F.R. §§ 1.17 and 1.136(a), Applicant(s) respectfully petition(s) for a one (1) month extension of time for filing a reply in connection with the present application, and the required fee of \$110.00 is attached hereto.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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